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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/681,817	06/11/2001	Thomas Paul Feist	RD-28,432	6879

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EXAMINER

HEITBRINK, JILL LYNNE

ART UNIT

PAPER NUMBER

1732

DATE MAILED: 04/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/681,817

Applicant(s)

FEIST ET AL.

Examiner

Jill L. Heitbrink

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 March 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) 19-24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 and 25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Election/Restrictions

1. Claims 19-24 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on September 7, 2004.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claim 25 is rejected under 35 U.S.C. 102(b) as being anticipated by Japanese reference 11-149673.
4. The Japanese reference discloses the injection molding of a data storage media having a positive image of the primary surface features 4a and secondary features a-h formed into the surface of the plastic substrate 11. The fine differences a-h secondary features on an exposed surface of the disposed identifier layer of the stamper 4.
5. Claim 25 is rejected under 35 U.S.C. 102(e) as being anticipated by Dalla Verde Publication No. 2002/0081413 (provisional application filed on Dec. 27, 2000). Dalla

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Verde discloses a secondary feature on the stamper which is deposited on the stamper after the stamper has been sanded.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1, 6-18 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over either Japanese reference 11-149673 or Dalla Verde Publication No. 2002/0081413 taken together with either Baumgartner et al. Pat. No. 5,388,803.

8. The Japanese reference 11-149673 discloses the injection molding of a data storage media having a positive image of the primary surface features 4a and secondary features a-h formed into the surface of the plastic substrate 11. The fine differences a-h secondary features on an exposed surface of the disposed identifier layer of the stamper 4.

9. Dalla Verde discloses a secondary feature on the stamper which is deposited on the stamper after the stamper has been sanded.

10. Baumgartner discloses a multilayer insulated stamper with insulation 16, an etched layer 24 and a nickel protective layer 34. Baumgartner teaches the multilayer structure stamp being applied to conventional non-insulated molding (col. 8, lines 12-13).

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It would have been obvious to a person of ordinary skill in the art to provide an insulated layer in the stamper of the Japanese reference and Dalla Verde since stampers with and without insulation are known to have the surface features formed using the same process. The providing of the managed heat transfer layer within the stamper of the Japanese reference and Dalla Verde would improve the molding of the disk and would not interfere with the primary and secondary features on each side of the stamper.

11. The size of the secondary features is disclosed by the Japanese reference and Dalla Verde to be capable of forming a watermark on the optical disc substrate. The width of the peak or valley which forms the watermark would have obviously been within the claimed ranges so as to produce a watermark which is observable without interfering with the operation of the primary features.

12. Claims 2-5, 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over either Japanese reference 11-149673 or Dalla Verde Publication No. 2002/0081413 taken together with either Baumgartner et al. Pat. No. 5,388,803 as applied to claims 1, 6-18 and 25 above, and further in view of Kondo et al. Pat. No. 5,480,763.

13. Kondo teaches conventional stampers have pits and features formed by a laser beam, plasma etching or photolithography. The forming of the secondary features with a laser beam, plasma etching or photolithography would have been obvious to a person of ordinary skill in the art of forming a stamper since these are conventional forming methods for stampers.

Allowable Subject Matter

14. Claims 6 and 7 have been amended such that they are rejected as stated above. However, the subject matter of the original claim 6 wherein the identifier layer with the secondary features "is" a managed heat transfer layer of the selected group of materials would be allowable if rewritten in independent claim 1. The prior art does not teach the secondary features being formed on/in the managed heat transfer layer.

Response to Arguments

15. Applicant's arguments filed March 25, 2005 have been fully considered but they are not persuasive.

16. Applicant argues that the JP reference and Dalla Verde do not disclose a stamper having an identifier layer that comprises a managed heat transfer layer. Firstly, the presence of a managed heat transfer layer would not produce a product different from that disclosed in the JP reference or Dalla Verde, and thus the product by process claim 25 is anticipated by JP reference or Dalla Verde. See MPEP 2113, "[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964. Therefore the product of claim 25 is disclosed by the JP reference and Dalla Verde. Secondly, the stamper comprising more than one layer including a managed heat transfer layer is obvious in view of the

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advantages of the managed heat transfer layer. This layer placed between the first and second sides of the stamper would have been within the skill of the art of forming stampers.

17. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jill L. Heitbrink whose telephone number is (571) 272-1199. The examiner can normally be reached on Monday-Friday 9 am -2 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Colaianni can be reached on (571) 272-1196. The fax phone

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number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Jill L. Heitbrink
Primary Examiner
Art Unit 1732

jlh